

REMARKS

Claims 40-48 remain in this application. New claims 58-66 are added. Claims 40-48 and 58-66 are pending. Support for the amendments and new claims can be found throughout the specification, particularly at pages 30-32 and Figure 17.

The Board of Patent Appeals affirmed the rejection of claims 40-48 under 35 U.S.C. 103(a) as being unpatentable over Wiggins (U.S. Patent Number 5,463,727).

Claim 40 recites each shape being separated from an adjacent shape by a spacing distance based on border parameters. Regarding the Examiner's prior position that the "border parameters" are the positions of the horizontal and vertical borders of the rectangular icons in Wiggins, the Board of Patent Appeals concluded that such an interpretation of the border parameters "does not address the actual claim language of 'each shape being separated from an adjacent shape by a spacing distance based on border parameters'." The Board of Patent Appeals further held that "it does not seem accurate to say that the distance is 'based' on border parameters." (Decision on Appeal dated October 31, 2003, page 7).

However, the Board of Patent Appeals relied on alternate grounds to conclude that Wiggins nevertheless suggested the present invention. The Board of Patent Appeals agreed that Wiggins fails to teach or suggest "border parameters" but nevertheless concluded that given the "arrangement of icons in Fig. 1 [of Wiggins]," the designer "*must have* specified a particular distance between icons" (Decision on Appeal dated October 31, 2003, page 6 – emphasis added). The Board further stated that the "specified distance values" that determine the spacing of

elements in Fig. 1 of Wiggins “can be called anything, including ‘border parameters’,” and that “...The fact the arrangement of icons is not important to Wiggins and, so, is not described in words, does not negate the teaching value of the uniform spacings shown in Fig. 1 [of Wiggins].” (Decision on Appeal dated October 31, 2003, page 6). Important to the Board of Patent Appeal’s line of reasoning is the assumption that because the icons in Fig. 1 of Wiggins appear to be “set to [a] predetermined value ... so, ... the distance can be termed a ‘spacing distance based on border parameters’.” (Decision on Appeal dated October 31, 2003, page 6).

The Decision on Appeal overlooks the fact that even if distances between the icons of Fig. 1 of Wiggins “appear constant”, Wiggins still fails to teach or suggest “a spacing distance based on border parameters.” The Decision provides no rationale as to why a distance that “appears constant” must, in fact, be based on “border parameters” as defined in the specification. Instead, the reasoning provided in the Decision indicates that the spacing distances in Fig. 1 of Wiggins “appear constant”. From that, the Decision concludes that therefore, the distances must be “clearly specified”. The Decision continues the analysis by assuming that if the distances are “clearly specified”, then somebody “must have specified a particular distance.” If somebody “specified a particular distance”, then one can arbitrarily call this specified distance “border parameters” (or, in fact, any name at all). See Decision on Appeal dated October 31, 2003, pages, 6 and 8). Presumably, the Decision on Appeal would further argue that after arbitrarily calling the “specified distance” in Wiggins “border parameters”, that the “border parameters/specified distance” in Wiggins is precisely what is disclosed in the specification of the present invention. However, the Decision misinterprets the term “border parameters” as meaning anything at all,

rather than as defined in the specification. Claim terms are not to be interpreted in a vacuum, rather, claim terms should be interpreted in light of the specification. *In re Marosi*, 70 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983).

A careful analysis of Wiggins as well as the present specification reveals that the term “border parameters” recited in claim 40 is not the same as the “specified distance” (or whatever the Board of Patent Appeals calls it) of Wiggins. Even if one were to rename the “specified distance” as “border parameters” as the Board of Patent Appeals attempts to do, the “border parameters” of the present invention would not be equivalent to the “border parameters” (or whatever one calls it) of Wiggins, notwithstanding the same name. The Decision admits that “Wiggins does not describe spacing the rectangular icons using ... the terminology ‘border parameters’.” In fact, Wiggins does not describe the spacing of the rectangular icons at all, much less with the border parameters as disclosed in the specification of the present invention.

The Decision asserts that the spacing in Wiggins is not “random” because they “appear constant.” Decision on Appeal dated October 31, 2003, page 8. This assertion is made in response to Applicant’s prior statement that “... at best, the distance between rectangles in Fig. 1 of Wiggins is randomly determined as there is no discussion at all in Wiggins as to how it is determined, if at all.” The Decision misinterprets Applicant’s prior argument. Applicants did not indicate that the spacing of rectangles in Fig. 1 of Wiggins was “random” in *size*, rather, the argument was that the distance was, at best, *randomly determined*. Thus, whether the spacing in Fig. 1 of Wiggins “appears constant” or not (the Decision contends the distances “appear constant”) is irrelevant. The question is how this distance was *determined* in Wiggins. For

example, if this distance is 1 cm, then why is it 1 cm? If the distance is 2 cm, then why was 2 cm determined? Applicants did not imply that, for example, one distance was 1 cm, another was 2 cm, another was 3 cm, etc. Rather, the question is what criteria is used to determine the ultimate distance to use. Wiggins fails to teach or suggest any method or criteria for determination of the distance. In fact, as the Decision states, “the arrangement of icons is not important to Wiggins.” Decision on Appeal dated October 31, 2003, page 8. Indeed, as the Decision on Appeal indicates, the spacing of icons is clearly *not* important to Wiggins as evidenced by the fact that Wiggins fails to provide any teaching or suggestion at all as to how the spacing is determined, if at all. Therefore, Wiggins fails to teach or suggest the “border parameters” as recited in claim 40. Therefore, the rejection is improper and should be withdrawn.

To clarify “border parameters”, claim 40 has been amended to more clearly recite the “border parameters”. Claim 40, as amended, recites the border parameters being adjustable and being selected from the group consisting of an x-border parameter, a y-border parameter and a width parameter. Wiggins fails to teach or suggest an x-border parameter, a y-border parameter or a width parameter as recited.

Claim 40, as amended, further recites that the size of an enlarged shape surrounding the current selection is adjustable by controlling the border parameters to display the enlarged shape surrounding the current selection in relation to the spacing of the menu options, wherein the controlling of said border parameters comprises altering at least one of the x-border parameter, the y-border parameter or the width parameter. Wiggins fails to teach or suggest that an enlarged shape surrounding a current selection is adjustable by controlling the border parameters. Wiggins

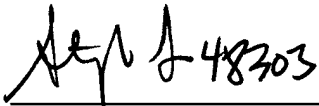
also fails to teach or suggest controlling the border parameters to display the enlarged shape surrounding the current selection in relation to the spacing of the menu options.

For at least the reasons set forth above, the rejection of claim 40 should be withdrawn. Claims 43 and 46 are similar to claim 40 and are allowable for at least the reasons set forth above for claim 40. Claims 41 and 42 depend from claim 40, claims 44 and 45 depend from claim 43 and claims 47 and 48 depend from claim 46. Therefore, claims 41, 42, 44, 45, 47, and 48 are allowable for at least the reasons set forth above.

Claims 58-66 depend from claim 40, 43, or 46 and are allowable for at least the reasons set forth above.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,



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